IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of: **Burnett et al.**   :

For Patent For: **SPIROSUBSTITUTED**   :
PIPERIDINES AS SELECTIVE MELANIN   :
CONCENTRATING HORMONE RECEPTOR   :
ANTAGONISTS FOR THE TREATMENT OF   :
OBESITY   :

Group Art Unit: 1625

Examiner: Rita J. Desai

Serial No.: **10/607,051**   :

Filed: **06/26/2003**   :

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Schering-Plough Corporation
Kenilworth, New Jersey 07033

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the species election requirement mailed on June 3, 2004 for the above-identified application, applicants respond as follows. A response for this restriction requirement was due on July 3, 2004. Therefore, this response, as mailed with a request for one-month extension of time, is to be considered timely.

The Examiner stated that Claims 1-26 are pending in the application.

The Examiner restricted the claims into three groups:

Group I covering claims 1-15, 16, 17 and 20, drawn to compounds wherein n is 0, r is 1, Ar is aryl, R^4 is aryl and Y is $(CR^2R^3)_pCO-NH$ and R^1 is "as given in the compounds of claim 16".

Group II covering claims 1-15, 17 and 20 drawn to compounds where n, r, Ar, Y and R^1 are different from those of Group I.

Groups III claims 18, 19, 21 and 22-26 drawn to methods of treatment. The examiner did state however, upon election of one of the above groups, we would be allowed one method of treating drawn to the compounds of the group we elected.

The Examiner advised applicants to elect a Group to be examined and to identify the claims reading thereon.

Applicants are puzzled by the restrictions of the claims by the Examiner and believe that claims 1-26 form part of one and the same invention. Applicants believe that when there is a linking generic claim encompassing the scope of all the compounds, pharmaceutical compositions comprising them and methods of treatment using them, it is inappropriate to restrict the invention to a single compound. Applicants also believe that due to such commonality a complete examination of claims 1-26 would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions. Applicants are equally confused as to why the methods of treatment that rely on the compounds and pharmaceutical compositions of elected Group I have been restricted out. Applicants also are of the belief that Groups I and II are so closely related that it would not cause an undue burden to the Examiner to examine them together. At a minimum, applicants respectfully suggest that those claims of Groups III, that rely on the compounds of group I, should NOT be restricted out of the pending application. However, applicants agree with the Examiner's point that upon selection of a group, that a method of treatment associated with the group will be considered with the compounds elected.

Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, for the sake of facilitation of prosecution and in order to comply with the Examiner's requirement, Applicants initially elect the claims that the Examiner has identified as belonging to Group I, with traverse.

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The Examiner is requested to call the undersigned attorney on any matter connected with this application.

Respectfully submitted,
SCHERING-PLOUGH CORPORATION

By:

Dated: **July 27, 2004**
SCHERING-PLOUGH CORPORATION
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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450 ON _____JUIY 27, 2004_____ .   _____William Y. Lee, **REG. NO. 46,100**_____
                                    (DATE OF DEPOSIT)   (REGISTERED REPRESENTATIVE)

_____Will~Lee   7/27/64_____
          (SIGNATURE AND DATE)

WYL:sa

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